

Serial No. 10/633,779

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Applicants: Eric James Converse et al.  
Application No. 10/633,779  
Filed: August 4, 2003  
Title: OPTICAL AMPLIFIER CONTROLLER HAVING  
ADJUSTABLE SLEW RATE LIMITER  
Art Unit: 3663  
Examiner: Deandra M. Hughes  
Docket No.: D2780 Con

Via Facsimile: 703-872-9327  
Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO OFFICE ACTION**

Sir:

11/30/2004 EBURNS 00000001 501047 10633779  
Sale Ref: 00000001 DAH: 501047 10633779  
01 FC:1814 110 following remarks:

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Nov 16 2004 9:49 P.02

MAYER FORTKORT WILLIAM Fax:908-518-7795

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### **REMARKS**

Claims 7-25 are pending in the application. Claims 1-6 were canceled in the Amendment filed August 18, 2004. Claims 7 and 15 are independent claims. The Examiner's indication of the Allowability of Claims 7-25 is appreciated.

### **Obviousness-type Double Patenting**

Claims 1-25 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of US Patent 6,611,374.

In order to overcome this rejection, a terminal disclaimer in compliance with 37 CFR 1.321(c) was filed with the Amendment filed on August 18, 2004. Per the Examiner's comments on page 2 of the Office Action mailed 11/02/04, the Terminal Disclaimer inadvertently referred to an incorrect prior patent number. Accordingly, a corrected Terminal Disclaimer is filed herewith. Withdrawal of the double patenting rejection is respectfully requested.

### **CONCLUSION**

Applicant submits that all pending claims are patentable over the cited references and that the application is in condition for allowance.

If a telephone conference would facilitate examination of this application in any way, the examiner is invited to contact applicants' attorney.

### **FEES**

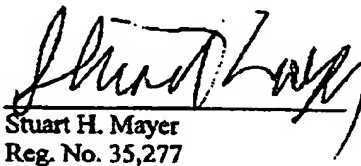
The Terminal Disclaimer fee under 37 CFR 1.20(d) of \$110 was charged to the undersigned attorney's PTO Deposit Account #50-1047 on September 2, 2004 (see enclosed copy of PTO Deposit Account statement). It is believed therefore that no additional fees are due. If any additional fees are due as a result of this Response, the

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undersigned attorney authorizes the Commissioner to charge such fees to Deposit  
Account 50-1047.

The examiner's consideration of this matter is gratefully acknowledged.

Respectfully submitted,

By:   
Stuart H. Mayer  
Reg. No. 35,277

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this document, and any document referenced  
herein, has been transmitted via facsimile to the US Patent and  
Trademark Office at (703) 872-9327 on 11/16/04.

Marjorie Scariati  
(Printed Name of Person Faxing Correspondence)

Marjorie Scariati  
(Signature)

PTO/SB/28 (09-04)

Approved for use through 07/31/2006, OMB 0651-0031

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# TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT

Docket Number (Optional)  
02780 Con

In re Application of: Eric James Converse et al.

Application No.: 10/633,779

Filed: 08/04/2003

For: OPTICAL AMPLIFIER CONTROLLER HAVING ADJUSTABLE SLEW RATE LIMITER

The owner, General Instrument Corporation, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. 6,811,374 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

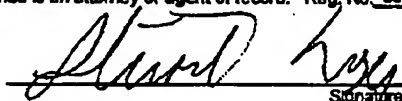
- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

- ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

- ☒ The undersigned is an attorney or agent of record. Reg. No. 35,277

  
Signature

11/15/04  
Date

Stuart H. Mayer  
Typed or printed name

908-518-7700  
Telephone Number

- ☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

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\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/98 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1460, Alexandria, VA 22313-1460.

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